

**REMARKS/ARGUMENTS**

Claims 1-13 and 27-44 are pending. By this Amendment, claims 14-26 are cancelled without prejudice or disclaimer; claims 6, 7, and 10 are amended; and claims 32-44 are added. Reconsideration and allowance in view of the above amendments and the following remarks are respectfully requested.

Claims 1-7 and 9-13 were rejected under 35 U.S.C. §103(a) over Ho (U.S. Patent 6,435,184). The rejection is respectfully traversed.

The Office Action on page 2 identifies the motor 27 and the fan 34 of Ho as corresponding to the air flow generator of claim 1. The Office Action acknowledges that Ho does not disclose or suggest that the motor 27 and the fan 34 are capable of creating a pressure of about 2-40 cm H<sub>2</sub>O in the chamber formed between the shell and the wearer's face. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to modify the gas mask structure of Ho to operate at a pressure of about 2-40 cm H<sub>2</sub>O since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. The Office Action cites the precedent of In re Aller, 220 F.2d 454, 105 USPQ 233 (CCPA 1955).

M.P.E.P. §2144.04 states that if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the Examiner may use the rationale used by the court. It is respectfully submitted that the facts of In re Aller are not sufficiently similar to those in the instant application to permit the Examiner to use the rationale used by the court.

The precedent of In re Aller is discussed in M.P.E.P. §2144.05IIA. In that precedent, a claimed process which was performed at a temperature of between 40°C and 80°C and an acid concentration between 25% and 70% was held to be *prima facie* obvious over a reference

process which differed from the claims only in that the reference process was performed at a temperature of 100°C in an acid concentration of 10%.

In the instant application, it is respectfully noted that Ho do not disclose or suggest any range or value of pressure that the motor 27 and a fan 34 are capable of generating within the rear cup body 1 of the gas mask structure. Accordingly, Ho does not disclose or suggest the general conditions of claim 1. The Examiner's reliance on the precedent of In re Aller is therefore insufficient to establish a *prima facie* case of obviousness.

It is also respectfully noted that M.P.E.P. §2144.05IIB states that a particular parameter must first be recognized as a result-effective variable, i.e. a variable which achieves a recognized result, before the determination of the optimum or workable ranges of the variable might be characterized as routine experimentation. That M.P.E.P. section cites the precedent of In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In the instant application, there is no recognition by Ho that the pressure in the gas mask structure can be varied to achieve a recognized result.

It is also respectfully submitted that it is improper to simply cite a precedent without an accompanying analysis of the facts reported in that precedent in providing a fact based statement why those facts are so similar to the instant application if the same conclusion should be reached. As set forth in In re Cofer, 354 F.2d 664, 667, 148 USPQ 268, 271 (CCPA 1966), "necessarily it is facts in the record, rather than prior decisions in and of themselves, which must support the legal conclusion of obviousness under 35 U.S.C. §103." As also noted in KSR International v. Teleflex Inc., 550 US 398, 418 (2007), "rejections on obviousness grounds cannot be sustained

by mere conclusory statements; instead there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness."

It is respectfully submitted that the Office Action does not present any articulated reasoning with some rationale underpinning to support the conclusion of obviousness of claim 1. It is also respectfully submitted that there is no reason why one of ordinary skill in the art would have modified the gas mask structure of Ho so that the motor 27 and fan 34 create a pressure of about 2-40 cm H<sub>2</sub>O in the gas mask structure.

Ho discloses that the motor 27 is powered on to operate for driving the fan 34 to suck in air through the second filter body 5 and the filter body 4. The air is purified from impurities and toxins and the cleaned air then flows into the rear cup body 1 for the user 6 to breathe. See column 3, lines 39-44. There is nothing in this disclosure of Ho that would provide one of ordinary skill in the art with a reason to provide a pressure of about 2-40 cm H<sub>2</sub>O in the rear cup body 1.

Claims 2-7 and 9-13 recite additional features and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein. Claims 27-31 also recite additional features and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) over Ho are respectfully requested.

Claim 8 was rejected under 35 U.S.C. §103(a) over Ho in view of Frater et al. (U.S. Patent 6,772,760). The rejection is respectfully traversed.

Claim 8 recites additional features and is allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein. In addition, it is

respectfully submitted that Frater et al. fail to cure the deficiencies of Ho discussed above with respect to claim 1 and even assuming it would have been obvious to combine the references, which Applicant does not concede, such a combination would not include all of the claimed features and would not present a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection of claim 8 under 35 U.S.C. §103(a) are respectfully requested.

New claims 32-37 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

New claim 38 recites a CPAP system comprising a mask and a flow generator, each comprising features not disclosed or suggested by the prior art. New dependent claims 39-44 depend from claim 38 and are allowable at least by virtue of their dependency.

In view of the above amendments and remarks, Applicants respectfully submit that all of the claims are allowable and the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_ /John P. Darling/  
John P. Darling  
Reg. No. 44,482

JPD:tlm  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100